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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/626,376	07/24/2003	Robert S. Greeff	57226-A-RE	2506

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EXAMINER

LAVINDER, JACK W

ART UNIT	PAPER NUMBER
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3677

DATE MAILED: 03/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/626,376

Applicant(s)

GREEFF, ROBERT S.

Examiner

Jack W. Lavinder

Art Unit

3677

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 February 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-3 and 21 have been rejected under 35 U.S.C. 102(b) as being anticipated by Rosenberg, D389425.

Regarding claims 1-3, 21, Rosenberg, D389425, discloses a “mixed-cut” gemstone having a crown formed with “step-cut” facets and a pavilion formed with “brilliant-cut” facets, i.e. facets radiating from the center culet (bottom point in figure 7) of the stone towards the girdle (figures 5-8). The stone has four corners wherein the corner length is less than the length of the two sides of the stone (top and bottom sides in figures 5 and 8). The pavilion of the stone is defined by eight or more substantially straight rib lines extending from the girdle to the culet (figure 8).

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 4-20 and 22-23 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Rosenberg in view of the Octo-Square Brilliant reference.

Art Unit: 3677

Regarding claims 4-8, 12-14, 16-20, and 22-23, Rosenberg discloses three and four facets along the rib lines, but fails to disclose only two facets along the rib lines. Rosenberg also discloses that two of the pavilion sides have three facets and the other two sides have six facets. The courts have noted that matters relating to ornamentation only, which have no mechanical function, cannot be relied upon to patentably distinguish the claimed invention from the prior art. *In re Seid*, 161 F.2d 229, 73 USPQ 431 (CCPA 1947). The Octo-Square Brilliant reference shows a pavilion with eight rib lines and only two facets per rib line as an alternative design choice for cutting the pavilion. Furthermore, the number of facets on only of the sides or corners is a matter of design choice, because it only changes the look of the stone. There is not asserted utility or criticality to the number of facets or shape of the facets on the pavilion of the stone. It would have been an obvious design choice to only have two facets along the rib lines of Rosenberg's gemstone in order to change the look of the gemstone to make it more appealing to wearer's of the gemstone.

Regarding claims 9 and 15, Rosenberg also discloses that each pavilion side and corner extends entirely to the culet.

Regarding claim 10, Rosenberg also discloses that the pavilion is devoid of any facet intersection lines parallel with the girdle.

Regarding claim 11, Rosenberg discloses each pavilion side and corner has a facet with a facet corner at the culet.

The examiner would like to point out that applicant is merely claiming the shape of the gemstone for ornamental purposes. The courts have noted that a change is

Art Unit: 3677

shape would be obvious to a person having ordinary skill in the art absent any teachings of unexpected results or criticality of the shape. Furthermore, as stated above, the courts have also noted that matters relating to ornamentation only, which have no mechanical function, cannot be relied upon to patentably distinguish the claimed invention from the prior art. *In re Seid*, 161 F.2d 229, 73 USPQ 431 (CCPA 1947).

Therefore, the shape of the gemstone and the number of facets on the pavilion rib lines, sides or corners are for ornamental purposes only. The disclosure and the remarks from applicant have failed to set forth any unexpected results from the shape, number, size and/or orientation of the pavilion facets on the gemstone, such as, the fire, color or brilliance of the stone has been magnified by tenfold. This hasn't been shown or disclosed. Therefore, it is concluded that the shape of the gemstone and the number of facets on the pavilion rib lines, sides or corners are for ornamental purposes only and according to the courts cannot patentability distinguish over the prior art.

### ***Response to Arguments***

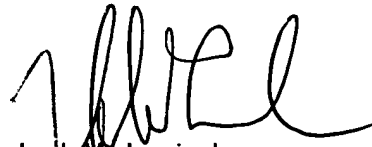
5. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jack W. Lavinder whose telephone number is 571-272-7119. The examiner can normally be reached on Mon-Friday, 9-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Judy Swann can be reached on 571-272-7075. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3677

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jack W. Lavinder  
Primary Examiner  
Art Unit 3677

3/13/06